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PATENT DEPARTMENT
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OFFICE OF PETITIONS

In re Application of :
Gallagher, Smith, Adkins, Hooley, :
and Dymond : DECISION REFUSING STATUS
Application No. 09/866,967 : UNDER 37 CFR 1.47(a)
Filed: 29 May, 2001 :
Att'y Docket No. MP/W-21927/A/AC 536:

This is in response to the petition under 37 CFR 1.47(a)¹ filed on 23 January, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

¹A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

The above-identified application was filed on 29 May, 2001, without an executed oath or declaration. Accordingly, on 26 July, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring, *inter alia*, a signed oath or declaration and a surcharge for its late filing. In response, on 23 January, 2002 (certificate of mailing date 13 November, 2001), petitioners submitted, *inter alia*, a declaration naming Michael G. Gallagher, Hal G. Smith, Steve Adkins, Anne Francis Hooley, and Brian Dymond as joint inventors and signed by all of the joint inventors except Smith on behalf of themselves and joint inventor Smith; the late-filing surcharge, the present petition under 37 CFR 1.47(a) and authorization to charge the petition fee, and a request and payment of the fee for a two (2) month extension of the time to reply to the Notice mailed on 26 July, 2001.

Petitioners assert that a copy of the declaration was sent to Smith, but that he has orally refused to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) and (2).

In regards to item (1), petitioners have not provided sufficient proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent to the non-signing inventor.² The declaration of petitioners' registered patent attorney, David R. Crichton, states that he sent a copy of the declaration and a power of attorney were sent to Smith, but omits to mention whether a copy of the application papers were sent to the non-signing inventor.

Petitioners may show proof that a copy of the application was

²MPEP 409.03(d).

sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers.³ If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

With regards to item (2), in the space for the citizenship of non-signing inventor Smith the declaration reads "BRITISH" but contains a line through the country of citizenship. As such, the declaration does not clearly state the citizenship of non-signing inventor Smith. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67 signed by all of the signing inventors and clearly stating the mailing address, residence, if different from the address at which the inventor receives mail, and the citizenship of all inventors must be provided with any renewed petition.

The petition fee of \$130.00 will be charged to counsel's deposit account, No. 03-1935.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions


By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

³Id.

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Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.


Douglas I. Wood
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy